UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID S. DE LORENZO, STEPHEN W. MONTGOMERY, WARREN R. MORROW, and ROBIN STEINBRECHER

Appeal 2006-1056
Application 10/606,514
Technology Center 2100

Decided: February 16, 2007

Before KENNETH W. HAIRSTON, LEE E. BARRETT, and HOWARD B. BLANKENSHIP, Administrative *Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING[1]

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[1] APJ Barrett replaces original panel member APJ Krass, who has retired from the USPTO. Legal support for substituting one Board member for another can be found in *In re Bose Corp.*, 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985).

INTRODUCTION

Appellants' Request for Rehearing (filed Aug. 29, 2006) contends that we erred in our Decision on Appeal entered June 29, 2006, in which we sustained the rejection of claims 1-4, 13-16, and 25-28 under 35 U.S.C. § 102(e). Appellants do not appear to contend that we erred in our reversing of the rejection of claims 5-7, 17-19, and 29-31.

OPINION

Instant claim 1 recites that the controller is "adapted to calculate a temperature estimate of the device. . . ." Appellants submit in the Request that we erroneously interpreted, or eliminated, the claim element.

In our Decision at page 9 we noted that, as explained by the Examiner, the prediction of a temperature (a temperature estimate) may be "calculated" by summing the power dissipated by I/O devices. We further noted that Appellants admitted in the Brief that the temperature of Nizar's device "has some relationship to the sum of the power dissipation." We agreed with the Examiner's position that the calculation of power dissipation is a determination or "calculation" of a temperature estimate, as recited in claim 1.

We therefore disagree with Appellants' characterization, at the first page of the Request, that we appeared to acknowledge that the reasoning applied by the Examiner is incorrect.

We discussed additional embodiments in Nizar on which instant claim 1 reads. Although we are not persuaded that we misapprehended or overlooked anything in noting other reasons why the claim is anticipated by

Nizar, even assuming we did, the basis for the Examiner's finding of anticipation remains.

Contrary to any suggestion in Appellants' Request, we do not contend that Nizar inherently, as opposed to expressly, describes the subject matter of instant claim 1. The Examiner's reasoning is based on the breadth of the recitation of "to calculate a temperature estimate of the device." That Nizar does not use the same words to describe subject matter within the scope of the claims does not require any inquiry into inherency. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. However, this is not an "ipsissimis verbis" test. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990).

Appellants now contend that any "reasonable claim construction" of the recitation of "calculate a temperature estimate" requires some type of calculation of an "actual" temperature value. It should be apparent that an "estimate," by definition, is not an "actual" value. In any event, since claim 1 does not specify that an "actual" temperature is calculated, or even that an "actual" temperature is used in calculating the estimate, Appellants refer to the instant specification and contend that all the examples of calculating a temperature estimate requires the "actual" calculation of an "actual" temperature value.

We consider the position to be untenable for at least four reasons. First, our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) (en banc). Second, Appellants have the ability (and duty) to amend the

claims, to the extent that support is found in the specification, to avoid the prior art. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." *In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Third, the Examiner has indicated that dependent claims 10-12, 22-24, and 34-36 are drawn to allowable subject matter; those claims specify calculations containing an "actual" (ambient) temperature and thus appear to be commensurate with Appellants' present arguments. Fourth, Appellants' specification (¶ 47) expressly states that the invention is not limited to the disclosed examples.

We are thus not persuaded that claim 1 requires, under a broad but reasonable interpretation, actual calculation of an actual temperature value. We hold to the view that Nizar's description of package and die temperatures being predicted by summing the power dissipated by the various I/O interfaces (e.g., col. 11, l. 52 - col. 12, l. 2) falls within the broad meaning of, and thus anticipates, the recitation of "adapted to calculate a temperature estimate of the device" as recited in claim 1.

CONCLUSION

In summary, we have granted Appellants' request for rehearing to the extent that we have reconsidered our decision sustaining the rejection of claims 1-4, 13-16, and 25-28, but we decline to modify the decision in any way.

DENIED

PGC/ GW

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